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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,112	05/31/2001	John S. LeFevre	035451-0129 (3631.Palm)	9793
26371	7590	03/10/2005	EXAMINER	
FOLEY & LARDNER 777 EAST WISCONSIN AVENUE SUITE 3800 MILWAUKEE, WI 53202-5308			DALENCOURT, YVES	
			ART UNIT	PAPER NUMBER
			2157	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/871,112

Applicant(s)

LEFEVRE ET AL.

Examiner

Yves Dalencourt

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 10-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is responsive to amendment filed on 11/10/2004.

#### ***Response to Amendment***

The examiner has acknowledged the amended abstract, and the amended claim 15. The rejections of claim 15 under 35.U.S.C. 112, second paragraph, and claims 17 - 19 under 35.U.S.C. 112, first paragraph have been withdrawn.

#### ***Response to Arguments***

Applicant's arguments filed on 11/10/2004 have been fully considered but they are not persuasive.

Applicant(s) asserted that Narayanaswami does not disclose or teach providing a separate launching application on a handheld computer, the launching application displaying an icon on the handheld computer that is representative of the email application (page 9, second paragraph). However, the examiner contends that Narayanaswami does suggest a menu 302 of selectable icons, for example, icon 314 is selected in order to launch an application directed to retrieving/storing/displaying e-mail messages, icon 316 for launching an application directed to retrieving/storing/displaying digital photographs and bit-mapped images (see col. 7, lines 17 – 35). ). It appears that Applicants argued more than what is being claimed. The claims are not as specific as being argued by the Applicants.

The examiner disagrees with the precedent assertion. The examiner kindly submits that the applicant(s) misread the applied references used in the rejection. However, when read and analyzed in light of the specification, the invention as claimed does not support applicants' assertions. Actually, applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejection. The aforementioned assertion wherein Narayanaswami fails to teach applicant's claimed element "providing a separate launching application on a handheld computer, wherein the launching displaying an icon on the handheld computer that is representative of the email application", was unsupported by objective factual evidence and was not found to be substantial evidential value. For this assertion to have merit, it is important to applicants provide some forms of evidence that convincingly show that examiner's references do not meet the claims language. It is important to note that the limitation the Applicants are relied upon is not described the specification in a way to enable one having ordinary skill in the art to make and use the invention. Furthermore, applicants are reminded that 37 CFR 1.111(b) states, "a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirement of this section". Thus, applicants' assertions are just mere allegation with no supported fact by failing to specifically point out how the language of the claims patentably distinguished them from the cited references. Applicants are reminded that the examiner is entitled to the broadest reasonable interpretation of the claims. The Applicants always have the opportunity to amend the claims during prosecution and

broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater 162 USPQ 541, 550-51 (CCPA 1969). Hence the 35 U.S.C 102 is hereby sustained.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10 – 15 and 17 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Chandrasekhar Narayanaswami (US 6,678,535; hereinafter Narayanaswami).

Regarding claims 10 and 15, Narayanaswami teaches a method of using an e-mail application in a wireless environment (314, fig. 4), which comprises the steps of providing an e-mail application not configured for use over a wireless connection on a handheld computer (col. 10, lines 9 – 12; Narayanaswami discloses a smart pervasive dock protocol adapter 500 equipped with a content transcoder device 530 for transcoding received data on the fly, such as a huge e-mail message that is eventually destined to be received by the Wrist Watch); providing a launching application on a handheld computer, the launching application displaying an icon on the handheld computer representative of the e-mail application (icon 314, fig. 4; col. 7, lines 17 – 20);

starting the launching application (col. 7, lines 23 - 25); modifying parameters of the handheld computer, by the launching application, so that the e-mail application is able to use a wireless connection (see paragraph bridging col. 6, line 64 through col. 7, line 8; col. 10, lines 12 – 23; Narayanaswami discloses, however, a transcoder device software that converts the web page into a format more suitable for viewing on the smaller handheld device, e.g. by converting color images to gray scale images or changing the resolution of the images so that they fit on the smaller device. The transcoder device of the smart pervasive dock protocol adapter device will be notified of the characteristics of the communicating input and output devices so that additional optimizations/conversions may be performed); and running, automatically, the e-mail application (paragraph bridging col. 4, line 63 through col. 5, line 8; Narayanaswami discloses an icon 314 on the system display to launch an e-mail application; once such icon is selected, the e-mail application would run automatically).

Regarding claim 11, Narayanaswami further teaches the step of connecting wirelessly to an e-mail server (fig. 3; col. 3, lines 28 – 34; col. 6, lines 35 - 39).

Regarding claim 12, Narayanaswami further teaches the step of sending an e-mail to the e-mail server (col. 6, lines 41 – 44; Narayanaswami discloses a user interface manager 255 processing events received from user input devices such as a touch panel for the appropriate applications).

Regarding claim 13, Narayanaswami teaches that the handheld computer includes a radio frequency transceiver (col. 4, lines 2 – 7 and lines 53 - 62).

Regarding claim 14, Narayanaswami teaches that the launching application started by selecting the icon representative of the e-mail application (col. 7, lines 17 - 25).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chandrasekhar Narayanaswami (US 6,678,535; hereinafter Narayanaswami).

Regarding claim 16, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the application supported is the microbrowser which enables access to a WAP supporting Web-based communications

written in, for example, the Wireless Markup Language (WML) using the XML standard (see col. 7, lines 1 – 8), but fails to explicitly teach that such application is a web clipping application.

However, one skilled in the art recognizes that substituting the microbrowser which enables access to a WAP supporting Web-based communications written in, for example, the Wireless Markup Language (WML) using the XML standard for the web clipping application as claimed would be within the level skilled of an artisan in the art.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a microbrowser for a web clipping application as claimed, since both are data applications and protocols that allow users to browse the Internet on small device screens, for the purpose of providing a user friendly and convenient navigation of displayed information in a handheld device, so that a large amount of data can be viewed in the relatively small size of the display's device.

Regarding claim 17, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the modifications to the parameters of the handheld computer includes removing operating system incompatibilities with the software application (see fig. 8a; col. 7, lines 17 – 25; col. 11, lines 8 – 39; Narayanaswami discloses an icon 314 for launching an application directed to retrieving/storing/displaying e-mail messages, which will make necessary modifications to the software operating system in order to be compatible with the Wrist Watch device).

Regarding claim 18, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the modifications to the parameters of



the handheld computer includes removing hardware incompatibilities with the software application (see fig. 8a; col. 7, lines 17 – 25; col. 11, lines 8 – 39; Narayanaswami discloses an icon 314 for launching an application directed to retrieving/storing/displaying e-mail messages, which will make necessary modifications to the hardware devices in order to be compatible with the Wrist Watch device).

Regarding claim 19, Narayanaswami teaches a method of using an e-mail application in a wireless environment, wherein the modifications to the parameters of the handheld computer includes removing display incompatibilities with the software application (see fig. 8a; col. 7, lines 17 – 25; col. 11, lines 8 – 39; Narayanaswami discloses an icon 314 for launching an application directed to retrieving/storing/displaying e-mail messages, which will make necessary modifications to the software operating system in order to be compatible with the Wrist Watch device).

Regarding claim 20, Narayanaswami teaches a method of using an e-mail application in a wireless environment, which further comprises the step of selecting the icon of the launching application (figs. 4 and 5; col. 7, lines 17 - 58).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2157

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

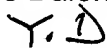
### **Contact Information**

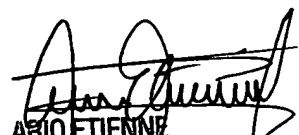
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

  
March 2, 2005

  
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